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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/901,692	07/28/97	KAMAKURA	A 1095.1076/JD
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TM11/1025

EXAMINER

KAZIMI, H

ART UNIT

PAPER NUMBER

2164

DATE MAILED:

10/25/00

*JS*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/901,692

Applicant(s)  
Kawasaki-Shi et al.

Examiner  
Hani Kazimi

Group Art Unit  
2164



☒ Responsive to communication(s) filed on Aug 10, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1, 3-12, and 14 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 3-12, and 14 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

1. This action is responsive to the communication filed on August 10, 2000.

#### ***Status of Claims***

2. Of the original Claims 1-10, claims 1, and 2 have been amended by Applicants' amendment filed on March 25, 1999. The same amendment has added claims 11-14. In the amendment filed on March 10, 2000, claims 2, and 13 have been canceled, and claims 1, 11, 12, and 14 have been amended. In the amendment filed on August 10, 2000, claim 3 has been amended. Therefore, claims 1, 3-12, and 14 are under prosecution in this application.

#### ***Response to Applicant's Amendment***

3. Examiner acknowledges Applicants' filing of a verified English translation of Japanese Patent Application No. Hei 8-309036 with this amendment and a certified copy of the same application, and therefore withdraws the previous office action's rejection under 35 U.S.C. § 103 regarding this matter. Applicants' remaining traversals are discussed within the following rejection under 35 U.S.C. § 103, and Applicants' request for allowance is respectfully denied.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

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rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

6. Claims 1, 3-12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. US Patent No. 5,794,207 in view of Wyman "a model for improving consumer acceptance of telemarketing", hereinafter Wyman.

Claims 1, and 11, 12, and 14, Walker teaches a marketing system and method for processing market information of consumers and dealers via an electronic network (abstract, and figure 1), comprising:

personal information registering means for registering personal information of a consumer (figure 2, element 255, and column 13, lines 1-10);

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market information registering means for registering market information about services which the consumer desires to purchase (figure 5, elements 510-550, and column 15, line 60 thru column 16, line 45);

posting means for extracting and posting the market information registered in said market information registering means according to genres (column 15, line 46 thru column 16, line 11, column 17, lines 8-26, and column 27, lines 20-36); and

personal information acquiring means for acquiring personal information of the consumer necessary for a dealer to access the consumer from said personal information registering means when the market information posted at said posting means is purchased (column 13, lines 1-53, and column 19, lines 55-60).

Walker fails to teach the prior approval demand determining means for determining, based on the personal information registered in said personal information registration means, whether prior approval by the consumer is required before the dealer accesses the consumer, and access confirming means for seeking approval for access by the dealer from the consumer who registered the purchased market information, when prior approval is required.

Wyman teaches the steps of determining, based on the personal information registered in said personal information registration means, whether prior approval by the consumer is required before the dealer accesses the consumer, and seeking approval for access by the dealer from the consumer who registered the purchased market information, when prior approval is required (page 1).

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Therefore, it would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Walker to include steps of determining, based on the personal information registered in said personal information registration means, whether prior approval by the consumer is required before the dealer accesses the consumer, and seeking approval for access by the dealer from the consumer who registered the purchased market information, when prior approval is required because, it benefits both the dealers and the consumers by better understanding of the consumer's needs and better targeting of promotional programs, and it provides a secure system by preventing any consumer's confidential information from being exposed to other dealers. Also, Walker supports the use of a secure system by using cryptography such as maintaining public/private key information on both buyers and sellers.

Claim 3, both Walker and Wyman fail to teach that the access confirming means cancels the purchase of the market information by the dealer when the consumer does not approve the dealer's access.

Official notice is taken that canceling a purchase or an order based on denying access is old and well known in the art.

It would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Walker to include the step of canceling the purchase of the market information by the dealer when the consumer does not approve the dealer's access because, it greatly improves the efficiency of the system by reducing unnecessary

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processing.

Claims 4, and 5, Walker teaches that the personal information registered in said personal information registering means includes a type of access to the consumer ((column 13, lines 1-53, and column 19, lines 55-60); and

the type of access includes at least one of indirect or direct electronic mail, indirect or direct facsimile transmission, indirect or direct mail of material, telephone call, and visit (column 13, lines 1-53, and column 19, lines 55-60).

Claim 6, Walker teaches that the personal information registered in said personal information registering means includes pre-categorized information and format-free information (column 13, lines 1-53, and column 19, lines 55-60).

Claim 7, Walker teaches that the accounting means for charging the dealer when the dealer has purchased the market information posted at said posting means (column 12, lines 35-53, and column 20, lines 16-30).

Claim 8, both Walker and Wyman fail to teach the step of performing at regular intervals of time a process of inquiring of the consumer whether the consumer desires the market information to be continuously posted at said posting means.

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Official notice is taken that performing at regular time intervals an inquiry as to whether continuously post information is old and well known in the art.

It would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to implement the system of Walker to include the step of performing at regular intervals of time a process of inquiring of the consumer whether the consumer desires the market information to be continuously posted at said posting means because, it provides convenience to the consumer by keeping him/her updated of the posted information, it greatly improves the efficiency of the system by eliminating invalid postings, and provides both the consumers and the dealers with a system that is user friendly.

Claims 9, and 10, both Walker and Wyman fail to explicitly teach the point providing means for giving the consumer a bonus point when the consumer has registered the personal information or market information; and

the point providing means gives the consumer an extra point if the consumer purchases goods from the dealer who has purchased the market information.

Official notice is taken that bonus points and incentives for registering personal information and purchasing goods and services is old and well known in the art.

It would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to implement the system of Walker to include the point providing means for giving the consumer a bonus point when the consumer has registered the personal information or



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market information and when the consumer purchases goods from the dealer because, it provides the consumer the opportunity to save money on their purchases, and provides the dealers the chance to increase their sales.

*Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 7:30 AM to 4:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

The fax number for Draft, Informal, Formal, or Official faxes to Technology Center 2100 or to this Art Unit is (703) 308-6296 or 6306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Hani Kazimi

October 20, 2000

  
ERIC W. STAMBER  
PRIMARY EXAMINER